

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-11 are pending in this application, of which Claims 1-8 are amended and Claims 9-11 are new. The amendments and new claims find in the original claims. No new matter is added.

In the outstanding Office Action, Claims 1-4 and 6-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2002/0197955 (Witkowski et al.) and further in view of JP 2001-112071 (Sugiura et al.); and Claims 5 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Witkowski et al. in view of Sugiura et al. and further in view of U.S. Pat. App. Pub. No. 2001/0028297 (Hara et al.).

Claim 1 recites:

An information providing apparatus for transmitting desired information to information equipment loaded on a vehicle, comprising:  
communication means for sending and receiving desired data using radio communications; and  
**control means for monitoring a remote control signal from an electronic key** corresponding to a key-less entry system for the vehicle via said communication means, and for controlling operations of information output means for storing said information and sending said information to said vehicle as well as operations of the communication means, wherein **said control means starts up operations of said information output means using the remote control signal from said electronic key as a trigger to transmit said desired information to said vehicle.**

The outstanding Office Action asserts Witkowski et al. describe control means which starts up operation of information output means to transmit desired information using an automatic wireless data link when the electronic device **12** is within the vicinity of the vehicle **14**. See Fig. 1 and paragraph [0044]. The Office Action also concedes Witkowski et al. fail to describe control means for monitoring a remote control signal from an electronic key, as defined in Claim 1. The Office Action relies on combining Witkowski et al. with Sugiura et al. to describe this feature. Sugiura et al. describe a home automation system

where a keyfob provides a remote controlled trigger to start operations within the household. These operations include unlocking and locking the front door of the house, or turning on/turning off appliances. See paragraphs [0105]-[0108] of the machine translation of Sugiura et al. However, as discussed below, it is improper to combine Witkowski et al. and Sugiura et al.

Assuming arguendo it were proper to combine reference teachings, the combined teachings of Witkowski et al. and Sugiura et al. still fail to describe the invention as defined in any of the claims. As described in Witowski et al., a connection is created and data transfer is initiated once two corresponding devices are within range. Thus, the home server described in Witkowski et al. is monitoring for, e.g., Bluetooth devices to create a connection with and initiate a data transfer. Sugiura et al. describes initiating home automation processes using a signal from a key fob. If the devices were combined, the resulting system would create an automated connection/data transfer system which could also initiate home automation processes when an appropriate key fob signal is detected. In contrast, Claim 1 recites a “control means for monitoring a remote control signal from an electronic key ... wherein said control means starts up operations of said information output means using the remote control signal from said electronic key as a trigger to transmit said desired information to said vehicle.”

As to the combination of the cited references, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP §2143.01(VI); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As taught by Witkowski et al.:

Still another limitation with traditional methods for transmitting data between electronic devices has been the **lack of an “automatic” or “unconscious” connection** when the devices are in proximity with one another. By “automatic” or “unconscious” it is meant **an immediate communications**

**link which is established between two or more electronic devices as soon as the devices are within a certain range**, for example, ten meters, of each other without any command being input to any of the devices by the user. **This limitation has up until the present required the user to provide one or more commands to at least one of the electronic devices to begin the process of transferring data between the two devices.**

See paragraph [0010], Witkowski et al. (emphasis added).

Witkowski et al. clearly establish teaching an automatic or unconscious connection between devices. Moreover, Witkowski et al. teach that requiring a user to provide one or more commands to begin the process of transferring data is a critical limitation of the known art which the subject invention overcomes. Thus, the principle of operation of the invention described by Witkowski et al. is providing an automated connection/data transfer system based on proximity. In contrast, Sugiura et al. teach an electronic device transmitting a signal to begin a process of initiating home automation equipment, in contrast with the primary benefit and principle of operation of the invention described by Witkowski et al. By combining the teachings of Sugiura et al. with those of Witkowski et al., the invention described in Witkowski et al. changes the principle of operation of the Witkowski et al. invention being modified, and thus the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Furthermore, “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01(V); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As to the cited references, modifying the invention described in Witkowski et al. renders the invention unsatisfactory for its intended purpose because the automated characteristics are abolished by the signal transmission process and device described by Sugiura et al.

Moreover, “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR v.*

Teleflex, 550 U.S. 398 (2007), slip opn. at 12. “[T]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.” *In re Fulton*, 391 F.3d 1195, 1200-1201, 73 USPQ2d 1141, 1145-146 (Fed. Cir. 2004). As commented above, Witkowski et al. clearly criticizes, discredits and discourages a solution as presented by Sugiura et al., namely transmitting a signal to initiate the home automation process.

Additionally, the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of non-obviousness. MPEP §2145(X)(D)(3); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Using an electronic key as recited in Claim 1 to trigger a data transfer is contrary to the accepted wisdom taught by Witkowski et al., namely the automatic creation of a connection and automatically transferring data, which is indicative of non-obviousness.

It is thus improper to combine Witkowski et al. with Sugiura et al. Therefore, it is believed the rejection under 35 U.S.C. §103 in view of Witkowski et al. and Sugiura et al. is improper and should be withdrawn.

Claim 4 recites:

A vehicle capable of downloading desired information stored in prespecified information storage means, comprising:  
communication means for receiving a remote control signal from an electronic key relating to a key-less entry system; and  
control means for sending and receiving desired data via said communication means, wherein said control means executes an operation for locking a door of a vehicle with said remote control signal from the corresponding electronic key detected via said communication means, and then acquires said desired information received by said communication means according to said remote control signal as a trigger.

Claim 6 recites:

A method of providing information to a vehicle by transmitting desired information stored in prespecified information storage means to the vehicle, comprising:

starting up operations of said information storage means in response to a remote control signal from an electronic key relating to a key-less entry system as a trigger; and  
providing said desired information to the vehicle corresponding to said remote control signal.

Claim 9 recites:

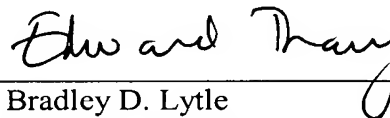
An information providing apparatus for transmitting desired information to information equipment loaded on a vehicle, comprising:  
a communication unit configured to send and receive desired data using radio communications; and  
a control unit configured to monitor a remote control signal from an electronic key corresponding to a key-less entry system for the vehicle via said communication unit, to control operations of an information output unit configured to store said information and send said information to said vehicle, to control operations of said communication unit, and further to initiate operations of said information output unit using the remote control signal from said electronic key as a trigger to transmit said desired information to said vehicle.

Claims 4, 6 and 9 also recite using a signal from an electronic key as a trigger to initiate a transfer of information. Thus, a combination of Witkowski et al. and Sugiura et al., assuming arguendo such is proper, also fails to describe the invention as defined in and of Claims 4, 6, 9 and any claims dependent therefrom.

Consequently, in view of the present amendment and in light of the above comments, the outstanding grounds for rejection are believed to have been overcome and the pending claims are believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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